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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,472	02/11/2005	Jurgen Meyer	032301.410	6924

25461 7590 01/12/2007
SMITH, GAMBRELL & RUSSELL
SUITE 3100, PROMENADE II
1230 PEACHTREE STREET, N.E.
ATLANTA, GA 30307-3592

EXAMINER

AHMED, SHEEBA

ART UNIT

PAPER NUMBER

1773

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/12/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/524,472	MEYER ET AL.	
	Examiner	Art Unit	
	Sheeba Ahmed	1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendments

1. Amendments to claims 1, 5, and 6 have been entered in the above-identified application. **Claims 1-17 are pending.**

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Hartmann et al. (US 5,959,005).

Hartmann et al. disclose silanized silica having a surface area, particle size, tamped density, pH value, carbon content and DBP number % as claimed in the instant application. The specific values are listed in the Table in Column 1. The silanized silica is produced by mixing with a surface modifying agent (i.e., hexamethyldisilazane) at a temperature of 100 to 400°C for a period of 1 to 6 hrs followed by compression by (lines 28-40). All limitations of claims 1-14 are disclosed in the above reference.

3. Claims 1, 5, 6, and 15-17 rejected under 35 U.S.C. 102(b) as being anticipated by Bock et al. (US 6,020,419).

Art Unit: 1773

Bock et al. disclose a transparent coating composition comprising a binder and nanoscale primary particles (Column 2, lines 61-64). Pyrogenic silicas are preferably used as the particles and surface modified silicas are particularly preferred. The surface is modified with agents such as hexamethylsilazane or dimethyldimethoxysilane (Column 3, lines 56-65). Suitable binders include polyurethanes (Column 4, lines 8-19). The Examples show that the transparent coatings may be applied to steel sheets or aluminum sheets (Column 8, lines 24-26). With regards to the limitation that the silicas have a tamped density of 280g/l or less, the Examiner takes the position that such a property limitation must be inherently present in the silicas taught by Bock given that the structure and chemical composition of the silica as taught by Bock and as claimed in the instant application are identical. All limitations of claims 1, 6, and 15-17 are disclosed or inherent in the above reference.

Response to Arguments

4. Applicant's arguments filed on October 23, 2006 have been fully considered but they are not persuasive.

Applicants traverse the rejection of claims 1-14 under 35 U.S.C. 102(b) as being anticipated by Hartmann et al. (US 5,959,005) and submit that Hartmann uses hexamethyldisilazane (HMDS) in the silanization process and hence, the Applicants argue, the result would be the formation of trimethylsilyl groups on the surface. However, the Examiner disagrees. The structure of HMDS, as shown in the attachment from the National Library of Medicine, contains six methyl groups but it is not clear how

Art Unit: 1773

many methyl groups are contained in the resulting structure in Hartmann, i.e., once the HMDS is attached to the silica. The Examiner invites the Applicants to show that the silanized silica of Hartmann does not contain the instantly claimed groups.

Applicants further traverse the rejection of claims 1, 5, 6, and 15-17 35 U.S.C. 102(b) as being anticipated by Bock et al. (US 6,020,419) and submit that the silicas of the instant invention show an improvement with respect to a coating composition as compared to the silicas of Bock. However, the Applicants are reminded that evidence of secondary considerations, such as unexpected results, is irrelevant to 35 U.S.C. 102 rejections and thus cannot overcome a rejection so based. In re Wiggins, 488 F.2d 538, 543, 179 USPQ 421, 425 (CCPA 1973).

Accordingly, the above rejections are maintained.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any


Art Unit: 1773

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheeba Ahmed whose telephone number is (571)272-1504. The examiner can normally be reached on Monday-Friday from 6am to 2pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571)272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Sheeba Ahmed
Art Unit 1773
January 7, 2007